



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,545	11/24/2003	Jean-Claude Marcotte	400500	4582

27717 7590 09/29/2004

SEYFARTH SHAW  
55 EAST MONROE STREET  
SUITE 4200  
CHICAGO, IL 60603-5803

EXAMINER

AMERSON, LORI BAKER

ART UNIT	PAPER NUMBER
----------	--------------

3764

DATE MAILED: 09/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/720,545	MARCOTTE, JEAN-CLAUDE	
	Examiner	Art Unit	
	L. Amerson	3764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2003.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/24/03</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- a. Claims 1-3, 9-10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Zaffaroni. Zaffaroni discloses a device comprising a first rounded end, second rounded end and an s-shaped intermediate portion having a fulcrum point and connecting the two ends (fig. 6). Regarding the language, "for exercising the Kegel muscle of a female", "for insertion into the female's vaginal/anal cavity", "such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity" and "for bearing against the front wall and back wall of the Kegel muscle" have not been given patentable weight because the recitations are purely functional in nature and do not recite any structure. As to claim 2, the fulcrum is proximate the second rounded end (fig. 6). As to claim 3, an arc on the intermediate portion is proximate the first end (fig. 6). As to claims 9 and 14, the recitations have not been given patentable weight because the limitations are purely functional in nature and do not recite any structure. As to claim 10, the intermediate portion is of circular cross-section.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

b. Claims 1-3, 9-10 and 15 are rejected under 35 U.S.C. 102(a) as being anticipated by Teran. Teran discloses a device comprising a first rounded (fig. 3) end, second rounded (fig. 3) end and an s-shaped intermediate portion having a fulcrum point and connecting the two ends (fig. 2). Regarding the language, "for exercising the Kegel muscle of a female", "for insertion into the female's vaginal/anal cavity", "such that the second rounded end may be inserted into the anal cavity once the first rounded end has been inserted into the vaginal cavity" and "for bearing against the front wall and back wall of the Kegel muscle" have not been given patentable weight because the recitations are purely functional in nature and do not recite any structure. As to claim 2, the fulcrum is proximate the second rounded end (fig. 2). As to claim 3, an arc on the intermediate portion is proximate the first end (fig. 2). As to claims 9, and 14, the recitations have not been given patentable weight because the limitations are purely functional in nature and do not recite any structure. As to claim 10, the intermediate portion is of circular cross-section. As to claim 15, the device is comprised of steel (col. 2, paragraph 0019).

c. Claims 17-18 are rejected under 35 U.S.C. 102(a) as being anticipated by Elmer. Elmer discloses the steps of inserting a first rounded end and second end into the vaginal cavity and contracting the sphincter muscles and resting on the pubic bone (col. 1, lines 26-40).

Art Unit: 3764

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

d. Claims 4-8, 10-12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zaffaroni as applied to claim 1 above and further in view of Elmer. Zaffaroni discloses all of the limitations of the claimed invention except for the ends being a spherical shape. Thus, Elmer teaches ends having a spherical shape. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the device of Zaffaroni in view of Elmer by creating spherical shaped ends because Applicant has not disclosed that the spherical shape provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with rounded ends because the shape of the ends serve no mechanical function and are capable of performing in the same capacity as spherical shaped ends. Therefore, it would have been an obvious matter of design choice to modify Zaffaroni in view of Elmer to obtain the invention as specified in the claims. As to claim 8, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the device of Zaffaroni in view of the teaching of Elmer by

creating a smaller diameter on the first sphere than the second sphere because Applicant has not disclosed that a smaller diameter on the first sphere provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the equivalent sized diameters because the shape of the spheres serve no mechanical function and are capable of performing in the same capacity as a equivalent shaped spheres. Therefore, it would have been an obvious matter of design choice to modify Zaffaroni in view of the teaching of Elmer to obtain the invention as claimed. Furthermore, absent a teaching as to criticality that the diameter of the first sphere be smaller than the diameter of the second sphere, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7,9 (CCPA 1975). As to claims 11-12, at the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the device of Zaffaroni in view of Elmer to include diameter dimensions of the first and second sphere as 5/8 inches and 1.1 inches respectively because Applicant has not disclosed that these specific dimensions provide an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any dimensions on the diameters because the size of the spheres serve

Art Unit: 3764

no mechanical function and are capable of performing in the same capacity as any size spheres. Therefore, it would have been an obvious matter of design choice to modify Zaffaroni in view of Elmer to obtain the invention as claimed. Furthermore, absent a teaching as to criticality that the diameter dimensions be 5/8 and 1.1 inch for the first and second sphere respectively, this particular arrangement is deemed to have been known by those skilled in the art since the instant specification and evidence of record fail to attribute any significance (novel or unexpected results) to a particular arrangement. In re Kuhle, 526 F.2d 553, 555, 188 USPQ 7,9 (CCPA 1975). As to claim 16, see the paragraphs above.

### ***Conclusion***

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to L Amerson whose telephone number is (703) 306-5576. The examiner can normally be reached on Mon.-Fri from 8-5 p.m. Interviews Tue. and Thur..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on (703) 308-2698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3764

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "L. Amerson".

L. Amerson